

### REMARKS

This amendment responds to the Office Action of September 29, 2004, in which rejected pending claims 1-20 as follows: (1) claims 1, 3, 9, 14, 15 and 20 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,050,996 to Schmaltz et al. (Schmaltz `996); (2) claims 2, 4, 8, 10, 12 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz `996; (3) claims 5, 7, 11, 13, 17 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz `996 in view of U.S. Patent No. 6,273,887 to Yamauchi et al. (Yamauchi `887); (4) claims 6 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz `996 in view of U.S. Patent No. 6,113,598 to Baker (Baker `598); and (5) claims 1-14 were rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over U.S. Patent No. 6,517,536 in view of Schmaltz `996.

Claims 1, 3 and 15 are the only independent claims in this application. Claims 2, 4-14 and 16-20 are dependent claims which depend either directly or indirectly from one of claims 1, 3 and 15.

In response to the Office Action, certain claims have been amended, where necessary, to further clarify the features recited in the claims. Each of claims 1, 3 and 15 recite, in part, jaws having include opposed clamping surfaces and at least three distinct elements, an elongated support member supporting substantially the entire length of its associated conductive ablation member, the elongated conductive ablation member of the

respective jaw and an insulator between them. As amended, claim 1 calls for each conductive ablation member to include a tissue contacting portion having a width which is substantially narrower than the width of the clamping surface.

These features are also recited in claims 3 and 15. Such features are fully supported by the specification and clearly shown, for example, in Figure 32. Figure 32 is a cross-sectional view of the jaws showing a structural support 82 (a support member), insulating members 84, 86 and 88 (an insulating material and insulator) and electrodes 94, 96 (conductive ablation members). Such features are described beginning at page 22 in paragraph 107 in the present application. At paragraph 109 and Figure 32 of applicant's disclosure, opposed tissue clamping surfaces 90 and 92 comprise insulating material at 88. The width of the tissue contacting portion of each electrode 94 and 96 is disclosed as having a substantially narrower width than the clamping surfaces 90 and 92.

The cited reference to Schmaltz '996 does not disclose or suggest the subject matter of claims 1, 3 and 15. The apparatus disclosed in Schmaltz '996 has a very different structure at each of its jaws 19 and 20. The jaws 19 and 20 include first and second electrodes 11 and 12 respectively. Each of the first and second electrodes 11 and 12 has an electrically conductive seal surface 24 and an electrically insulative substrate 25, as shown in Figures 5 and 7. In Figures 2 and 3, the clamping surface of each jaw is comprised essentially entirely of the respective electrode 11 and 12 such that the electrode width is clearly not

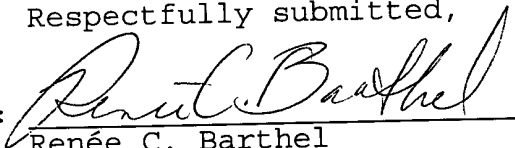
substantially narrower than the width of the clamping surface. In fact, in Figures 8 and 10, the width of the electrically conductive seal surface 24 is wider than the electrically insulative substrate 25 which provides only a slight marginal edge to the clamping surface.

For these reasons, each of claims 1, 3 and 15 is believed to be distinguishable over the cited reference to Schmaltz `996. As such, applicant respectfully submits that claims 1, 3 and 15 are not anticipated or obvious by Schmaltz `996, and thus are allowable. Each of the remaining claims 2, 4-14 and 16-20 is dependent either directly or indirectly from one of claims 1, 3 and 15 and is thus also believed to be allowable.

The rejection for double patenting over U.S. Patent No. 6,517,536 in view of Schmaltz `996 should also be withdrawn, at least with respect to Schmaltz `996, for similar reasons as discussed above.

Reconsideration and allowance are respectfully requested.

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